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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,504	12/01/2003	Gaynelle Andersen	SAM1363	1008
7590	10/04/2004		EXAMINER	
Sean A. Kaufhold P.O. Box 131447 Carlsbad, CA 92013			ASHLEY, BOYER DOLINGER	
			ART UNIT	PAPER NUMBER
			3724	

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/724,504	ANDERSEN, GAYNELLE	
	Examiner Boyer D. Ashley	Art Unit 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 10 is/are allowed.
- 6) Claim(s) 1-3 is/are rejected.
- 7) Claim(s) 4-9 is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/1/03.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_.

## DETAILED ACTION

### ***Information Disclosure Statement***

1. The information disclosure statement filed 12/01/03 has only been partially considered, that is, the reference to 3,759,23 (Taylor) dated 9/18/1973 has not been considered. The U.S. Patent number appears to be incorrect.

### ***Claim Rejections - 35 USC § 102 & 103***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Adams, U.S. Patent 3,628,407.

Adams discloses the same invention as claimed including: an elongated base (12) having a first end (24), a second end (36), a first side edge (see Figures 3-5), a second side edge (see Figures 3-5), a top side (see Figures 3-5) and a bottom side (see Figures 3-5), a compartment (16) being positioned within said base, the top side of the

base has an aperture (68) extending therethrough and into said compartment, the aperture located adjacent the first end (see Figures 3-5), the length between the first and second end greater than nine inches (see column 1, lines 40-50, where it is stated that the punch can punch 11 inch paper); an engaging arm (the lower portion of 44) being elongated and having rearward end (on the left) and a forward end (on the right), the rearward end being pivotally coupled (46 ) to said top side of the base and positioned adjacent to the second end such that the arm extends over the aperture (Figures 3-5); a piston (76) extending through and being movably mounted in the engaging arm, the piston including an upper arm portion (the upper portion of 76) extending upwardly from the engaging arm and a lower portion (the lower portion of 76) extending downwardly from the engaging arm (see Figure 3-5), the piston positioned such that it may extend through the aperture; a first biasing member (56) being coupled to the piston for biasing said lower portion upwardly away from the base; a second biasing member (50) being coupled to said engaging arm for biasing said forward end of said engaging arm upwardly away from the base; and an actuator (74) for selectively moving the lower portion of the piston downward and into said aperture being attached to said engaging arm.

In the alternative, even if it is argued that Adams lacks the length of greater than nine inches, however, it would have been an obvious matter of design choice to make the device of Adams greater than nine inches in order to punch larger pieces of paper as also implied by Adams, because such a modification would have involved a mere

change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art.

As to claim 2, the bottom side of Adams defines a door (see Figure 4).

As to claim 3, the engaging arm includes a cavity as shown in Figure 3, wherein the upper portion is capable of being removed.

***Allowable Subject Matter***

5. Claims 4-9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
6. Claim 10 appears to be allowable over the prior art of record.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boyer D. Ashley whose telephone number is 703-308-1845. The examiner can normally be reached on Monday-Thursday 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 703-308-1082. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3724

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Boyer D. Ashley  
Primary Examiner  
Art Unit 3724

BDA

September 29, 2004